

**REMARKS**

This Application has been carefully reviewed in light of the Final Office Action mailed July 12, 2005. At the time of the Final Office Action, Claims 1-17 were pending in this Application. Claims 18-20 were previously cancelled due to an election/restriction requirement. Claims 1-8 and 11-14 stand rejected, and Claims 9, 10 and 15-17 were allowed. Applicants respectfully request reconsideration and favorable action in this case.

**Rejections under 35 U.S.C. § 102**

Claims 1-5, 7, 8 and 13 stand rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 6,311,950 issued to Andreas Kappel et al. ("Kappel et al."). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Independent claim includes the limitation that the top plate of the actuator is fixed directly to an injector housing by **caulking** between the top plate and the injector housing. The Examiner maintained his position that Kappel discloses all limitations of independent claim 1. Applicants respectfully disagree.

The Examiner stated that Kappel shows caulked areas 20. However, numeral 20 clearly indicates merely that the top plate is welded to the housing. Contrary to the Examiner's interpretation, the term "caulking" and "caulked areas" as used in this application

will not encompass "welding." Welding requires that a weldable steel is used. Furthermore, welding does not include the mechanical process caused by caulking. Rather, welding actually either merges the welded areas by adding welding material which is attached to both the housing and the top plate. This additional material is particularly shown in Kappel with numeral 20. See Figs. 1 - 4 of Kappel. In addition, all figures of Kappel show no deformation of the housing which results from caulking. Applicants' specification, furthermore, clearly distinguishes "welding" and its disadvantages from the proposed term of "caulking." See paragraph [0004] on page 2 of the present application. Applicants believe that for a person skilled in the art the term "caulking" itself is clearly distinguished from "welding" and does not produce the same results. In particular, "caulking" does not cause the "merging" of the top plate and the housing that welding will generate. On the contrary, as best shown in figure 4 with 5, caulking causes a deformation of material to lock the actuator in position.

In addition, an applicant is allowed to be his own lexicographer. The present application clearly discloses what is meant by caulking. See all figures and associated description, in particular paragraph [0039] on page 9 of the specification. Thus, Applicants believe that claim 1 is not anticipated by the prior art.

**Rejections under 35 U.S.C. § 103**

Claims 6, 11, 12 and 14 stand rejected by the Examiner under 35 U.S.C. 35 U.S.C. §103(a) as being unpatentable over Kappel. Applicants respectfully traverse.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the

reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

**Allowable Subject Matter**

Claims 9, 10 and 15-17 are allowed.

**CONCLUSION**

Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the claims as amended.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2545.

Respectfully submitted,  
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